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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/374,577	08/13/1999	FORREST NABORS	34533-51	3935

7590

12/24/2002

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EXAMINER

CHOULES, JACK M

ART UNIT

PAPER NUMBER

2177

DATE MAILED: 12/24/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/374,577

Applicant(s)

NABORS ET AL.

Examiner

Jack M Choules

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 26 September 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-66,69 and 70 is/are pending in the application.
- 4a) Of the above claim(s) 1-47 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-66,69 and 70 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-47 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 August 1999 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. Claims 1-66, 69-70 are presented for examination. Claims 1-47 having been withdrawn from consideration. Claims 67, and 68 were nonexistent in amendment. Also please notice headings *Election/Restriction* and *Drawings* as the examiner could find no response to equivalent sections in the amendment of September 26, 2002, further lack of response will lead to abandonment. Full action is sent in interest of compact prosecution.

2. The text of those sections of Title 35, U.S. Code and the text of the rejections not included in this action can be found in a prior Office action and is incorporated by reference.

### ***Response to Arguments***

1. Applicant's arguments filed June 16, 1997 have been fully considered but they are not persuasive.

2. The Applicant argues that the claims recite data structures with physical impact and are clearly statutory subject matter as in the case of Lowry.

3. In response the examiner argues that previous statutory databases (such as Lowry) a clear relationship to the structure is set forth for example reciting “ a data structure stored on a computer readable memory” there is no such positive recitation in claim 48. Claim 48 Recites “A vehicle description language (VDL) employed by and between communicatively coupled computing systems to communicate information associated with a vehicle in support of application(s) executing thereon, the VDL employing a hierarchical data structure comprising:” in its preamble. The data structure has no positive recitations showing its relation to a computer it is *employed* by a vehicle description language the vehicle description language is *employed* by and between ... computing systems. This is a vague recitation of a nebular relationship existing between the data structure and does not establish statutory subject matter.
4. In reference to claim 58, signals are not statutory unless embodied on a carrier wave.
5. In reference to claim 69, a storage medium comprising content which when executed.
6. The applicant argues that the examiner uses hindsight reasoning.

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7. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). In this case the reasoning used a fact from the draft that personal data was involved and the very well known fact that the public wishes "its" personal information to remain private.

8. The applicant argues nonanalogous art

9. In response to applicant's argument that Stupek is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, Stupek is analogous because it deals with programming data structures on a computer. And even if considered non analogous shows the well known in the art solution to allowing different data to be access differently.

10. The applicant argues that public and private in Stupek are labels without definition or context.

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11. The examiner responds that although don't defined in Stupek the labels due have definition and meaning that is well known in the arts of computer programming and data processing an as such should not need explaining. Regardless the claims as written are directed to non-embodied data structures. Thus in the claims the terms are only labels as there is no structure (and still would be no-structure even if made statutory by embodying the data structures) to provide the function of privacy the applicant is arguing anywhere in any of the claims

12. Applicant has not responded to election/restriction so it is repeated.

***Election/Restriction***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claim 1-47, drawn to a system for transmitting, to select sellers, requests for quotes, receive answers thereto, sending acceptances to quotes, after configuring a desired product, classified in class 705 subclass 26.

II. Claim 48-56, drawn to a vehicle description language created in a hierarchical data structure to store and transfer vehicle descriptions between computers via a computer network, classified in class 707, subclass 104.1. The inventions are distinct, each from the other because of the following reasons:

2. Inventions I and II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention I has separate utility such as it can be used for the exchange/sale of any type of product or service, not just for vehicles transactions. See MPEP § 806.05(d).

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3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, and the search required for Group I is not required for Group II, restriction for examination purposes as indicated is proper.

4. During a telephone conversation with Mr. Michael Proksch, Applicants' representative, (503-684-6200) on March 25, 2002, a provisional election was made without traverse to prosecute the invention of Group II, claims 48-56. **Affirmation of this election must be made by applicant in replying to this Office action.** Claims 1-47 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

13. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

#### ***Claim Rejections - 35 USC § 101***

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 48-68 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claims are apparently directed to a Data structure Per se as it is not clearly claimed as embodied in a computer readable media or a signal on a carrier wave. See Warmerdam, 33 F.3d at 1360-1361 (claim to computer having specific memory held statutory, claim to data structure per se held non-statutory).

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

8. Claims 48-66 and 69-70 are rejected under 35 U.S.C. 103(a) as being unpatentable over Draft Proposal [hereinafter the draft] "An Industry Standard Data Format for the Export and Import of Automotive Customer Leads" in view of Stupek, Jr. et al. [hereinafter Stupek] US Patent No. 6,131,118. (Note: the draft was provided by the applicant in a IDS provided 13 March 2000 further although the art does not predate CIP priority application number 09/188,863 the subject matter of the claims is not found in that application.)



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9. As to claims 48, 58, 69 and 70 the draft disclosed the invention substantially as claimed including a data processing system ['DP'] comprising a hierarchical data structure (page 6-14); delimiters (page 6-14); and blocks sub-blocks and categories and data items (page 6-14).

10. The draft does not detail a public and private blocks. Stupek describes a system that includes public and private data blocks (col. 25, lines 1-35) showing the concepts of private and public data was known. Also no attempted has been made to match the actual contents of the blocks, sub-blocks, categories data elements for example "manufacture, model, model year and style of the vehicle as this is all non-functional descriptive material and any difference in this rearrangement or non- functional descriptive material and considered well within the capabilities of one of skill in the art to implement Cf. In re Gulack, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983 (when descriptive material is not functionally related to the substrate, the descriptive material will not distinguish the invention from the prior art in terms of patentability)).

11. It would have been obvious to one of ordinary skill in the DP art at the time of the applicant's invention to combine the teachings of Stupek with the draft because the draft includes personal data (draft page 3) and it would have been obvious to protect this data from public distribution to protect the interests of the client in the system.

12. As to claims 49, 50, 59, and 60, the delimiters for the sub-blocks etc are considered to indicate block or sub-block they belong to by positioning (page 6-14) further linking the delimiters to the hierarchical element they depend on is considered obvious to maintain the hierarchal structure.

13. As to claims 51-55 and 61-65 these claims detail non-functional descriptive material and thus do not distinguish over the prior art (see explanation to rejection of claim 48 hereinabove).

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14. As to claims 56-66, the draft details XML (page 3).

15. Claims 48-66 and 69-70 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kozol et al. [hereinafter the Kozol] "An Industry Standard Data Format for the Export and Import of Automotive Customer Leads" in view of Stupek, Jr. et al. [hereinafter Stupek] US Patent No. 6,131,118. (Note: the draft was provided by the applicant in a IDS provided 13 March 2000 further although the art does not predate CIP priority application number 09/188,863 the subject matter of the claims is not found in that application.)

16. As to claim 48, 58, 69, and 70, Kozol disclosed the invention substantially as claimed including a data processing system ['DP'] comprising a hierarchical data structure (figure 1); delimiters (figure 1); and blocks sub-blocks and categories and data items (figure 1).

17. Kozol does not detail a public and private blocks. Stupek describes a system that includes public and private data blocks (col. 25, lines 1-35) showing the concepts of private and public data was known. Also no attempt has been made to match the actual contents of the blocks, sub-blocks, categories data elements for example "manufacture, model, model year and style of the vehicle as this is all non-functional descriptive material and any difference in this rearrangement or non-functional descriptive material and considered well within the capabilities of one of skill in the art to implement Cf. In re Gulack, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983 (when descriptive material is not functionally related to the substrate, the descriptive material will not distinguish the invention from the prior art in terms of patentability)).

18. It would have been obvious to one of ordinary skill in the DP art at the time of the applicant's invention to combine the teachings of Stupek with Kozol because doing so would

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protect sensitive data from public distribution to protect the interests providing the data to the system.

19. As to claims 49 and 50, the delimiters for the sub-blocks etc are considered to indicate block or sub-block they belong to by positioning (figure 1) further linking the delimiters to the hierarchical element they depend on is considered obvious to maintain the hierarchal structure.

20. As to claims 51-55 and 61-65 these claims detail non-functional descriptive material and thus do not distinguish over the prior art (see explanation to rejection of claim 48 hereinabove).

21. As to claims 56 and 66, Kozol details SGML (abstract) XML is a standard derived from SGML so it would be obvious to also use the features of the Kozol invention with XML, as it would extend to the functionality to the new standard.

### ***Drawings***

22. New formal drawings are required in this application because the draftsman objected to the drawings see PTO 948. Applicant is advised to employ the services of a competent patent draftsman outside the Office, as the Patent and Trademark Office no longer prepares new drawings. **The corrected drawings are required in reply to the Office action to avoid abandonment of the application.** The objection to the drawings will not be held in abeyance. Consider this notification of non-responsive reply abandonment will result with further lack of response.

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*Conclusion*

14. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

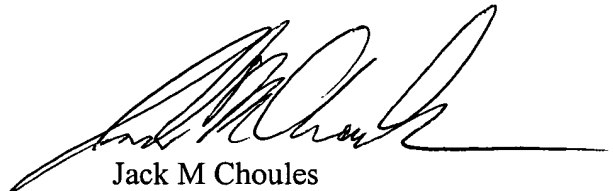
In accordance with applicants request a phone call was placed 12 December 2002 to the Paul Mendonsa of the firm of record a message was left but no response was received.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jack M Choules whose telephone number is (703) 305-9840. The examiner can normally be reached on M-F (7:30-4:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John E. Breene can be reached on (703) 305-9790. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 746-7239 for regular communications and (703) 746-7238 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

A handwritten signature in black ink, appearing to read 'Jack M Choules', with a long horizontal line extending to the right.

Jack M Choules  
Primary Examiner  
Art Unit 2177

JMC  
December 16, 2002